

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Byrne et al. : Art Unit: 3629  
Serial No.: 09/681,391 : Examiner: Igor N. Borissov  
Filed: March 28, 2001 :  
For: METHODS AND SYSTEMS :  
FOR PERFORMING USAGE :  
BASED BILLING :

**Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450**

**TRANSMITTAL**

1. Transmitted herewith is:  
Transmittal (3 pgs., in duplicate); Response to Restriction Requirement in response to  
Office Action dated March 18, 2005 (2 pgs.); Return post card

**STATUS**

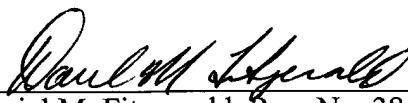
2. Applicant  claims small entity status.  
 is other than a small entity.

**CERTIFICATE OF MAILING BY EXPRESS MAIL TO  
THE COMMISSIONER FOR PATENTS**

Express Mail Label No.: EV458035070US

Date: April 18, 2005

I hereby certify that the documents listed above are being deposited with the United States  
Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10 on the  
date indicated above in an envelope addressed to Mail Stop Amendment, Commissioner for  
Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

  
\_\_\_\_\_  
Daniel M. Fitzgerald, Reg. No. 38,880

**EXTENSION OF TERM**

3. The proceedings herein are for a patent application and the provisions of 37 C.F.R. 1.136 apply.

(complete (a) or (b), as applicable)

(a)  Applicant petitions for an extension of time under 37 C.F.R. 1.136  
(Fees: 37 C.F.R. 1.17(a)-(d) for the total number of months checked below:)

Extension for response within:	Other than small entity Fee	Small entity Fee (if applicable)
<input type="checkbox"/> first month	\$ 120.00	\$ 60.00
<input type="checkbox"/> second month	\$ 450.00	\$ 225.00
<input type="checkbox"/> third month	\$ 1,020.00	\$ 510.00
<input type="checkbox"/> fourth month	\$ 1,590.00	\$ 795.00
<input type="checkbox"/> fifth month	\$ 2,160.00	\$ 1,080.00
	Fee Due	\$ _____

If an additional extension of time is required, please consider this a petition therefor.  
(Check and complete the next item, if applicable)

An extension of \_\_\_\_\_ months has already been secured. The fee paid therefor \$\_\_\_\_\_ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$

**OR**

(b)  Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

**FEE FOR CLAIMS**

4. The fee for claims (37 C.F.R. 1.16(b)-(d)) has been calculated as shown below:

	(Col. 1)		(Col. 2)	(Col. 3)	SMALL ENTITY		OTHER THAN SMALL ENTITY
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	ADDITIONAL RATE FEE	OR	ADDITIONAL RATE FEE
TOTAL INDEP.		MINUS		=	x \$9 = \$		x \$18 = \$0.00
		MINUS		=	x \$44 = \$		x \$88 = \$0.00
<u>— FIRST PRESENTATION OF MULTIPLE DEP. CLAIM</u>				+ \$150 = \$			+ \$300 = \$
				TOTAL ADDITIONAL FEE \$	OR	TOTAL ADDITIONAL FEE \$	

(a)  No additional fee for Claims is required

**OR**

(b)  Total additional fee for claims required \$

**FEE PAYMENT**

5.        Attached is a check in the sum of \$\_\_\_\_\_

Charge Deposit Account No. 01-2384 the sum of \$  
A duplicate of this transmittal is attached.

**FEE DEFICIENCY**

6.  If any additional extension and/or fee is required, charge Deposit Account No. 01-2384.

**AND/OR**

If any additional fee for claims is required, charge Deposit Account No. 01-2384.

7.  Other:

  
\_\_\_\_\_  
Daniel M. Fitzgerald  
Reg. No. 38,880  
ARMSTRONG TEASDALE LLP  
One Metropolitan Square, Suite 2600  
St. Louis, MO 63102  
314/621-5070

4-19-05

EN3629

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APR 18 2005

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PATENT

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**RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner for Patents  
Mail Stop AMENDMENT  
Washington, D.C. 20231

Sir:

The Office Action mailed March 18, 2005 has been carefully reviewed and the following remarks have been submitted in consequence thereof. In response to the election requirement set forth in the Office Action, Applicants elect, with traverse, for prosecution in this application all claims of Group I as identified in the Office Action. Claims 1-9 and 13-45, drawn to a system and method for monitoring a customer's equipment, are in the elected claim group.

Reconsideration of the restriction requirement imposed under 35 U.S.C. § 121 is respectfully requested. The restriction requirement is traversed because the inventions set out by the claims in Groups I and II are clearly related. Applicants submit that a thorough search and examination of each of these claim groups would be relevant to the examination of the other group and would not be a serious burden on the Examiner. Indeed, the claims of Group I are directed to a system and method for monitoring a customer's equipment using data from a meter, and the claims of Group II are directed to a method of generating invoices related to equipment usage by a customer. Clearly, the claims of Group I and the claims of Group II are related. Accordingly, Applicants submit that it would not present an unreasonable burden on the

Examiner to examine both these claim Groups. For at least this reason, it is respectfully submitted that the restriction requirement is improper and should be withdrawn.

The restriction requirement with respect to the claims in Groups I and II is further traversed. The Office Action asserts that the claims in Groups I and II are “related as subcombinations disclosed as usable together in a single combination” and that the “subcombinations are distinct from each other if they are shown to be separately usable.” The Office Action further asserts that the claims in Group I recite “utility separate from that of the invention B such as remote monitoring of a production facility.” Applicants respectfully disagree with this assertion and submit that the system and method recited in the claims of Group I and the method recited in the claims of Group II are both directed to monitoring a customer’s equipment for billing purposes. Moreover, the Office Action does not describe how it is possible that the system and method recited in the claims of Group I have a separate utility from the method recited in the claims of Group II other than merely stating that the system and method recited in the claims of Group I can be used for remote monitoring of a production facility. Applicants submit that the method recited in the claims of Group II could also be used for the remote monitoring of a production facility. Accordingly, Applicants submit that Group I and Group II subcombinations are not patentably distinct.

In addition, requirements for restriction are not mandatory under 35 U.S.C. Accordingly, reconsideration of the restriction requirement is requested.

Respectfully Submitted,

  
Daniel M. Fitzgerald  
Registration No. 38,880  
ARMSTRONG TEASDALE LLP  
One Metropolitan Square, Suite 2600  
St. Louis, Missouri 63102-2740  
(314) 621-5070